

1. The art rejections over WO 2005068134 have been withdrawn because WO'134 is not a prior art against the claimed invention. The international publication date of WO '134 is July 28, 2005 which is after the effective filing date of the present invention.
2. The art rejections over Okuda and Matsuda separately are maintained.
3. The provisional obviousness-type double patenting rejection over Application No. 10/562,447 has been withdrawn in view of the present argument.
4. The provisional obviousness-type double patenting rejections over Application No. 10/551,459 and Application No. 10/586,341 separately are maintained.

Information Disclosure Statement

5. In response to Applicants' request to consider the Information Disclosure Statement (IDS) submitted on July 25, 2006, a copy of the properly initialed IDS is provided to Applicants as an attachment.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, and 21-24 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 2004108322. Okuda et al (US 2006/0141159) will be relied on as an equivalent form of WO 2004108322. Okuda teaches an anisotropic electrically conductive film comprising an expanded porous PTFE film with a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes (figure 3f). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction (paragraph 83). Okuda does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Okuda uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as Applicants for forming the expanded porous PTFE of the present invention (paragraphs 81-83, 254 and figures 4A-B). The sintered porous PTFE is further compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by Okuda. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation

occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Accordingly, Okuda anticipates or strongly suggests the claimed subject matter.

9. The art rejections over Okuda have been maintained for the following reasons.

Applicants contend that Okuda does not teach the compression step after the sintering step, therefore the product of Okuda is not structurally the same as an expanded porous PTFE film of the present invention. The examiner respectfully disagrees. The examiner directs Applicants' attention to paragraph 254. The sintered porous PTFE is further compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by Okuda. Accordingly, the art rejections are sustained.

10. Claims 1-4, and 21-24 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2004-265844. Masuda et al (US 2006/0251871) will be relied on as an equivalent form of JP 2004-265844. Matsuda teaches an anisotropic electrically conductive film comprising an expanded porous PTFE film with a plurality of through holes therein and a conductive metal applied to wall surfaces of the through holes

(figure 7). The expanded porous PTFE has a microstructure composed of fine fibrils and nodes connected by the fibrils and elastic recovery property in the thickness direction (paragraphs 9, 11 and 52). Matsuda does not specifically disclose the film having a residual strain and elastic modulus set forth in the claims. It appears that Matsuda uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as Applicants for forming the expanded porous PTFE of the present invention (paragraphs 51, 64). The sintered porous PTFE is further compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by Matsuda. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property.

The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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Accordingly, Matsuda anticipates or strongly suggests the claimed subject matter.

11. The art rejections over Matsuda have been maintained for the following reasons.

Applicants contend that Matsuda does not teach the compression step after the sintering step, therefore the product of Okuda is not structurally the same as an expanded porous PTFE film of the present invention. The examiner respectfully disagrees. The examiner directs Applicants' attention to paragraph 64. The sintered porous PTFE is further compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by Matsuda. Accordingly, the art rejections are sustained.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-4 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/551,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '459 application teaches each and every limitation except for a residual strain and elastic modulus recited by the claims. It appears that the '459 application uses the same material and the same processing steps such as extruding, rolling, stretching, sintering and compressing as the present invention for forming the expanded porous PTFE of the present invention (paragraphs 51, 64). The sintered porous PTFE is further compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by the '459 application. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not

depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. The double patenting rejection has been maintained for the following reasons.

The '459 application teaches the compression step after the sintering step, therefore the product of the '459 application is structurally the same as an expanded porous PTFE film of the present invention. The examiner directs Applicants' attention to paragraph 254. The sintered porous PTFE is further compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by the '459 application.

15. Claims 1-4 and 21-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5 and 6 of copending Application No. 10/586,341. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '341 application teaches each and every limitation except for a residual strain and elastic modulus recited by the claims. It appears that the '341 application uses the same material and the same processing steps such as extruding, rolling,

stretching, sintering and compressing as the present invention for forming the expanded porous PTFE of the present invention. The sintered porous PTFE is further compressed to form a laminate with the 20 layers of the expanded PTFE layers fusion-bonded to each other (example 5). Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by the '341 application. Therefore, it is not seen that the residual strain and elastic modulus could have been outside the claimed ranges as like material has like property. The recitation "cushioning material", "sealing material" or "intracorporeally implanting material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. The double patenting rejection has been maintained for the following reasons.

The '341 application teaches the compression step after the sintering step, therefore the product of the '341 application is structurally the same as an expanded porous PTFE film of the present invention. The examiner directs Applicants' attention to example 5. The sintered porous PTFE is further

compressed to form a laminate with the three layers of the expanded PTFE layers fusion-bonded to each other. Likewise, it is clearly apparent that "compressing is a step subsequent to sintering" is anticipated by the '341 application.

Conclusion

- 17. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

- 18.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/
Primary Examiner, Art Unit 1794